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OFFICE OF PETITIONS

In re Application of	:	
Mikiya et al.	:	DECISION ON
Application No. 10/808,067	:	REQUEST FOR
Filed: 03/24/2004	:	RECONSIDERATION OF
Attorney Docket No.	:	PATENT TERM ADJUSTMENT
10210/10	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)" filed on September 12, 2008. Applicants request that the patent term adjustment at the mailing of the notice of allowance be increased by 291 days from 226 days to 517 days.

The application for patent term adjustment is **DISMISSED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is no (0) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On June 12, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment

(PTA) to date is 226. On September 12, 2008, applicants timely submitted the instant application for patent term adjustment¹.

Applicants request, in essence, correction of the patent term adjustment by two hundred ninety-one (291) days from two hundred twenty-six (226) days to five hundred seventeen (517) days. Specifically, petitioners request that the patent term adjustment be increased to 517 in accordance with 37 CFR 1.703(b)(4) as a result of delay between the filing of a notice of appeal and the mailing of the notice of allowance.

Applicants' argument is not well taken. 37 CFR 1.703(b)(4) states that the period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, **but not including the sum of the following periods:** The number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

Accordingly, applicant is not entitled to patent term adjustment under 37 CFR 1.703(b)(4) for the period between the filing of the notice of appeal and the mailing of the notice of allowance.

The relevant period of Office delay runs from the date of filing a compliant appeal brief, not the date of filing of a notice of appeal. Specifically, 35 U.S.C. 154(b)((1)(A)(ii) provides that the Office's failure to respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken constitutes examination delay. 37 CFR 1.703(a)(4) pertains to

¹ PALM records show that the Issue Fee was also received on September 12, 2008.

the provisions of 35 U.S.C. 154(b)(1)(A)(ii) and specifies that the period is the number of days, if any, beginning on the day after the date that is four months after the date an appeal brief in compliance with 37 CFR 41.37 was filed and ending on the mailing date of any of an examiner's answer under 37 CFR 41.39, an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first. In this regard, "the date on which" an "appeal was taken" in 35 U.S.C. 154(b)(1)(A)(ii) means the date on which an appeal brief (and not a notice of appeal) was filed. The phrase "appeal brief in compliance with 37 CFR 41.37" requires that: (1) the appeal brief fee (37 CFR 1.17(c)) be paid (37 CFR 41.37(a)); and (2) the appeal brief complies with 37 CFR 41.37(c)(1) through (c)(9).

In this regard, an appeal brief in compliance with 37 CFR 41.37 was filed on March 18, 2008. The notice of allowance was mailed on June 12, 2008, within four (4) months of the filing of the appeal brief in compliance with 37 CFR 41.37. Accordingly, no patent term adjustment is warranted under 37 CFR 1.703(a)(4).¹

Accordingly, the calculation of a 257 day period under 37 CFR 1.703(a)(4) as the number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with § 41.37 of this title was filed and ending on the date of mailing of a notice of allowance under 35 U.S.C. 151 is incorrect, as the appeal brief filed on May 29, 2007, was not in compliance with § 41.37. This period of patent term adjustment will be removed.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is no (0) days (85 (342-257) days of PTO delay reduced by 116 days of Applicant delay).²

The \$200.00 fee set forth in 37 CFR 1.18(e) has been received. No additional fees are required.

¹ See Response to Comment 38, Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule, 65 Fed. Reg. 56366, 56385-87 (Sep. 18, 2000).

² As the Office does not set forth negative balances of patent term adjustment, the patent term adjustment is properly set at no (0) days.

The application file is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, stylized flourish extending from the end of the name.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions